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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,353	12/08/2003	Ward Thomas Brown	A01474	1784
21898 7590 02/26/2007 ROHM AND HAAS COMPANY PATENT DEPARTMENT 100 INDEPENDENCE MALL WEST PHILADELPHIA, PA 19106-2399			EXAMINER SHOSHO, CALLIE E	
			ART UNIT 1714	PAPER NUMBER
			MAIL DATE 02/26/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/730,353

Applicant(s)

BROWN ET AL.

Examiner

Callie E. Shosho

Art Unit

1714

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 01 February 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☒ Applicant's reply has overcome the following rejection(s): 35 USC 112, second paragraph.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_.  
Claim(s) objected to: \_\_\_\_\_.  
Claim(s) rejected: 1-4, 8-10, 18 and 19.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

Callie E. Shosho  
Primary Examiner  
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**Attachment to Advisory Action**

1. Applicants' amendment filed 2/1/07 has been fully considered. While the amendment overcomes the 35 USC 112, second paragraph rejection of record, the amendment does not overcome the double patenting, 35 USC 102, or 35 USC 103 rejections of record for the following reasons.

Applicants argue that copending 10/642,791, i.e. Brown et al. (U.S. 2004/0054063), is no longer applicable against the present claims under 35 USC 103 in light of applicants' statement of common ownership set forth on page 5 of the amendment filed 2/1/07.

However, applicants have attempted to disqualify copending 10/672,791 (Brown et al.) under 35 U.S.C. 103(c) by showing that the invention was owned by, or subject to an obligation of assignment to, the same entity as copending 10/672,791 (Brown et al.) at the time this invention was made. However, applicant has failed to provide a statement that the application and the reference were owned by, or subject to an obligation of assignment to, the same person at the time the invention was made in a conspicuous manner, and therefore, is not disqualified as prior art under 35 U.S.C. 103(a). Applicant must file the required evidence in order to properly disqualify the reference under 35 U.S.C. 103(c). See MPEP § 706.02(I). In addition, applicant may overcome the applied art either by a showing under 37 CFR 1.132 that the invention disclosed therein was derived from the inventor of this application, and is therefore, not the invention "by another," or by antedating the applied art under 37 CFR 1.131.

It is noted that while applicants' statement establishes that "as of the time of filing of the instant application", each of the instant application and copending 10/672,791 (Brown et al.) is

subject to an obligation of assignment to Rohm and Haas Company, applicants have not provided a proper statement indicating common ownership or assignment of the instant application and copending 10/672,791 (Brown et al.) at the time the invention was made.

It is noted that if applicants were to submit a proper statement of common ownership, the 35 USC 103 rejection of record set forth in paragraph 14 of the office action mailed 12/1/06 as well as the rejections set forth in paragraphs 6-8 of the office action filed 12/1/06 would be overcome.

Applicants argue that Ma et al. (U.S. 6,247,808) is not a relevant reference against the present claims given that there is no disclosure in Ma et al. of polymer particles comprising polymerized units of phosphorous acid monomer and having first phosphorous acid groups. Applicants argue that while Ma et al. disclose pigment particles, there is no disclosure of polymer particles.

As evidence to support their position, applicants point to col.9, lines 16-18 of Ma et al. that disclose that the number of pendant ionic moieties should be sufficient to make the salt form of the cationic polymer soluble in the aqueous carrier medium. However, this portion of Ma et al. refers to the cationic polymer not the anionic polymer, i.e. polymer having first phosphorous acid groups, disclosed by Ma et al.

While it is agreed that there is no explicit disclosure that the polymer having first phosphorous acid groups disclosed by Ma et al. is in the form of particles, given that Ma et al. disclose that such polymer is obtained not only from hydrophilic monomers such as vinyl phosphonic acid but also hydrophobic monomers and further given that there is no requirement

that such polymer is neutralized, i.e. phosphonic acid groups in the polymer "may" be neutralized (col.8, lines 50-51), it would be appear that the polymer is in fact in the form of particles. Thus, it is not clear how applicants have determined that the polymer of Ma et al. is not in the form of particles. Clarification is requested.

Applicants argue that Dersch et al. (U.S. 6,492,451) and Edwards et al. (U.S. 7,101,921) are not relevant references against the present claims given that each reference fails to disclose polymers prepared by emulsion polymerization of phosphorous acid monomer at pH of less than 2 or composition having a level of water soluble polymers having second phosphorous acid groups defined by the ratios of equivalents of second phosphorus acid groups to equivalents of first phosphorous acid groups in the range less than or equal to 1.5 as presently claimed.

However, it is the examiner's position, as set forth in paragraphs 11-12 of the office action mailed 12/1/06, that Dersch et al. and Edwards et al. each meet the alternative requirement in the present claims that the composition comprises a level of water soluble polymers having second phosphorous acid groups defined by the ratios of equivalents of second phosphorus acid groups to equivalents of first phosphorous acid groups in the range less than or equal to 1.5. While applicants argue that neither reference meets this limitation, applicants have provided no evidence to support this position. With respect to Edwards et al. it is further noted that col.8, lines 46-49 disclose that the pH of the emulsion polymerization process is less than 8 which would clearly encompass pH of less than 2 as presently claimed.

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Applicants' state on page 6 of the amendment filed 2/1/07 that given that the double patenting rejection is provisional, if the present claims were otherwise allowable, the instant application would be passed to issue.

However, it is noted that even if the double patenting rejection were the only rejection remaining in the present application, given that the present application is the later-filed application, a terminal disclaimer is required before the double patenting rejection can be withdrawn and the application permitted to issue. See MPEP 804 I(B)(1).



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CS  
2/21/07